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| 09/847,699 | 05/02/2001 | Peter Forch | A-2664 | 6206 |

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EXAMINER

LOWE, MICHAEL S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3652

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,699

Applicant(s)

FORCH ET AL.

Examiner

M. Scott Lowe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/14/03 in paper 13.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 3,6 and 11-13 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 14 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Drawings /

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 4/14/03 in paper 12 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1,2,4,5 are rejected under 35 U.S.C. 102(e) as being anticipated by Holbert (US 5,984,301).

Re claims 1, Holbert teaches a device for aligning sheets 11 prior to transferring the sheets to a sheet processing machine 14 comprising at least one sheet-gripping device 16 by the aid of which the sheet to be aligned is displaceable, said sheet gripping device 16 having at least one positioning table 20 displaceable by an actuating drive 48 in at least one of a sheet travel direction, transversely to said sheet travel direction and in a direction wherein it is pivoted about an axis extending in a direction orthogonal to said sheet travel direction, the sheet to be aligned being fixable on said positioning table 20.

Re claim 2, Holbert teaches a contact surface with at least one opening connectable to a negative-pressure source 28.

Re claim 4, Holbert teaches the positioning table 20 integrated in a feeding table 10.

Re claim 5, Holbert shows the positioning table 20 supported by bars (not numbered, figure 3) on its underside. Holbert does not say whether the bars are elastic or inelastic but since the bars can only be elastic or inelastic and both cases would support the table, it is inherently taught for the bars to be elastic.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holbert (US 5,984,301).

Re claim 15, Holbert does not go into the details of the vacuum system since it is known in the industry (column 3, line 17) to use adjustable vacuum systems so that sheets with different properties can work with the same system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an adjustable vacuum system so that sheets with different properties could be used.

Claims 7-10, 14, 16-18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Holbert (US 5,984,301) in view of Gerlier (US 5,140,166).

Re claim 7, Holbert does not teach the actuating drive 48 having an electromagnet. Gerlier teaches an electromagnetic positioning unit 19 with at least one electromagnet 35 in order to move a rod 36 to align sheets. Since Holbert's servomotors do a similar job and Gerlier's unit 19 could be used as an equivalent, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced Holbert's servomotors with Gerlier's electromagnetic positioning unit to align sheets.

Re claim 8, although Gerlier is silent on the shape of the electromagnet, there is no reason in the specification as to why a U-shaped magnet is better than other shapes

and therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the electromagnet any known shape to make it fit in the available space in the device.

Re claims 9-10, Holbert teaches the positioning table 20 being of square polygonal construction. Furthermore, since the applicant did not specify why a particular shape was better than another, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make it shaped in any geometry to fit in the available space in the device.

Re claim 14, Holbert teaches a control and regulating device 26 for activating the positioning unit (which as modified Gerlier has a switchable electromagnet).

Re claim 16, Holbert teaches a sheet-detection device 24 coupled with a control and regulating device 26 forming a regulating circuit.

Re claim 17, Holbert as already modified by Gerlier, teaches the controller determining if there is to be an electric current flowing through the electromagnet (by turning it on or off).

Re claim 18, although Holbert teaches sensors 24 for locating the alignment of the sheets, Holbert is silent on Hall-effect sensors, and the applicant does not state why this sensor is more effective than other sensors. Since Hall-effect sensors are well known in the art it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Hall-effect sensors or any other similar sensors to locate the alignment of the sheets.

Allowabl Subject Matter

Claims 19-20 allowed.

Conclusion

Applicant's arguments filed 4/14/03 in paper 13 have been fully considered but they are not persuasive.

Regarding claim 1, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a single positioning table) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding applicant's argument that Gerlier, sheet alignment does occur through the electromagnet which moves the aligning device (pressure rollers 11) and thus it would be obvious to use the electromagnets to move Holbert's aligning device.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Scott Lowe whose telephone number is 703-305-1940. The examiner can normally be reached on 6:30am-4:30pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on 703-308-3248. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



EILEEN D. LILLIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

msl
June 30, 2003